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10/757,164	01/13/2004	Elliot A. Gottfurcht	4346P001X4	3554

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EXAMINER

COBURN, CORBETT B

ART UNIT PAPER NUMBER

3714

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/757,164

Applicant(s)

GOTTFURCHT, ELLIOT A.

Examiner

Corbett B. Coburn

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 23/8/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. Applicant's Formal Drawings have been received, but have not been scanned into the file. Therefore, Examiner cannot approve the drawing changes. Examiner suggests Applicant submit copies of the formal drawings on paper instead of Bristol board so that the drawings can be scanned into the file.

### **Claim Interpretation**

2. As pointed out in the previous office action, Applicant's claims are extremely broad. Examiner informed Applicant that some of the claims are so broad that they border on the indefinite. In the interest of prosecution, Examiner did not reject these claims under 35 USC §112. Instead, Examiner interpreted the claims to the best of his ability while, at the same time, urging Applicant to narrow the claims to more closely reflect Applicant's invention.

3. Examiner then pointed to claim 10 as a particularly egregious example of a claim that could have been rejected under 35 USC §112. In spite of Examiner's clear warning, Applicant declined to amend the claims and argued that if the claim was unclear it should have been rejected under 35 USC §112. Examiner has no choice but to make such a rejection. Since Applicant was put on notice that the claim was defective and could have been rejected under 35 USC §112, Examiner will make this rejection final.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 10 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a web interface, does not reasonably provide enablement for a simplified web interface. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicant has failed to describe the manner in which the web interface can be said to be "simplified". Applicant argues that it is simplified in comparison to Microsoft Internet Explorer, but the specification fails to mention that product – much less describe any ways in which applicant's invention is simpler.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10 recites, a "simplified navigation interface". It is unclear how this is simplified. Simplified compared to what? Applicant argues that it is simplified compared to Microsoft Internet Explorer, but the specification fails to mention Internet Explorer. In fact that is nothing in the claims, specification, or arguments explain just how this navigation interface is "simplified". It is simplified because it has fewer buttons? Or maybe because the fonts are easier to read. Or perhaps it is simplified because it has hotkeys that are easier to remember. There are hundreds – possibly thousands – of ways to "simplify" a web browser compared to Microsoft Internet Explorer. Applicant's claims fail to delineate which of these "simplifications" Applicant intends to claim as his own. Thus the metes and bounds of Applicant's claim are unclear.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3-5, 7-14, 16 & 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Xidos et al. (US Patent Number 5,851,149).

**Claims 1, 9, 14:** Xidos teaches displaying a web based game and receiving control input for the game from a television remote control. (Abstract) Xidos teaches that the network used the Internet protocol, therefore the games are web-based. The network described by Xidos is either the Internet or its equivalent.

**Claims 3, 10, 16:** Xidos teaches displaying a set of web-based games as navigation options. The player must have a means of choosing the game. Presumably, these navigation options could be more complex than they are, so they are “simplified” by comparison to some hypothetical “convoluted” navigation interface.

**Claims 4, 13, 17:** Xidos teaches receiving control input from a second television remote control. Fig 2 shows a large number of rooms (50) that may participate in playing the game. In each case, the input is provided by a remote control. Thus there is at least a second remote control providing input.

**Claims 5, 11:** The game is a gambling game. (Abstract)

**Claim 7:** Xidos teaches providing a game matching service to a user – the user chooses a game and is matched to that game.

**Claim 8:** The game control input is unique input – it is provided by each person and will, therefore, be unique to that individual.

**Claim 12:** Xidos teaches displaying the game remotely at a second location on a second television. Fig 2 shows a large number of rooms (50) that may participate in playing the game.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xidos as applied to claim 1 or 14 in view of Handelman et al. (US Patent Number 6,312,336).

**Claims 2, 15:** Xidos teaches the invention substantially as claimed. Xidos teaches displaying a set of game control options (i.e., game selection, betting and game play inputs), but does not specifically teach displaying a set of game control options in a matrix format. The arrangement of the game control options on the screen is a matter of aesthetic design choice for which no stated problem is solved, or unexpected result obtained, by using the specific arrangement of controls on the screen claimed versus the arrangement of controls on the screen taught by the prior art. Furthermore, matters of aesthetic design cannot patentability distinguish over the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Be that as it may, however, Handelman explicitly teaches displaying a set of game control options in a matrix format. (Figs 2A-E)

Arranging control options in a matrix format makes them easier to find and understand.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Xidos in view of Handelman to display a set of game control options in a matrix format in order to make them easier to find and understand.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xidos as applied to claim 1 above, and further in view of How to "Know When Your Buddies Are Online" (AOL, 1997).

**Claim 6:** Xidos teaches the invention substantially as claimed, but does not teach tracking the online status of a group of individuals designated by a user. Xidos teaches using Internet protocols as the basis for the disclosed system. A chat feature is a well-known feature of the Internet. Providing a chat feature is known to foster a sense of camaraderie that increases the use of a gaming system. (See Falciglia (US Patent Number 5,935,002) which is made of record but not relied upon.) As a part of providing a chat feature, it is well known to track the online status of a group of individuals designated by a user. AOL's Instant Messenger application implemented this not later than 1997. This allows the user to determine if the people he wants to chat with are available. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Xidos in view of the well known state of the art with regard to chat features (as described in "How to Know When Your Buddies Are Online") in order to allow the user to determine if the people he wants to chat with are available, thus fostering the chat feature that is known to attract players.

*Response to Arguments*

13. Applicant's arguments filed 16 August 2004 have been fully considered but they are not persuasive.

14. Applicant argues that Xidos does not teach the Internet. But Xidos teaches using the Internet protocol. Thus the network taught by Xidos is equivalent to the Internet. Thus the rejection under 35 USC §102 is proper. Note that a network that is equivalent to the Internet does not have to be part of the Internet.

15. Applicant argues that Examiner contradicts himself by stating that the layout of game control options on a screen is a matter of design choice and showing that it is well known to arrange control options in a matrix. There is no contradiction. Examiner could easily provide art that arranges game control options in a myriad of different configurations on a screen. Examiner is merely stating that it makes no difference where the control options are located, they function the same way. While not required, Examiner provided art that shows control options arranged in a matrix. Xidos teaches a game that has control options. Handelman teaches arranging control options in a matrix on the screen. The reasons for making the combination are stated above.

16. Applicant argues that, "The Examiner must establish that the cited references provide a motivation to combine." This is, of course, a misstatement of the law. The law actually is that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. (Emphasis added.) See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,



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Examiner supplied art (Falciglia) that taught the desirability of including a chat feature in a gambling device. Falciglia is knowledge generally available to one of ordinary skill in the art.

*Conclusion*

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

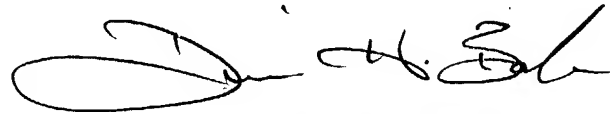
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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